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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/557,376	04/25/00	BORMANN	A BEIERSDORF 6

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EXAMINER

WELLS, L

ART UNIT	PAPER NUMBER
1619	8

DATE MAILED: 11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/557,376

Applicant(s)

BORMANN ET AL.

Examiner

Lauren Q Wells

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1. 6) ☐ Other:

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### **DETAILED ACTION**

Claims 10-18 are pending. Claims 1-9 were cancelled per the Amendment received May 7, 2001, Paper No. 4. Claim 13 is withdrawn from consideration, as it is directed to non-elected subject matter.

#### ***Election/Restrictions***

The Examiner acknowledges that a fully responsive election of species was made in the Amendment received May 7, 2001, Paper No. 4. The Examiner apologizes for this oversight.

The Examiner respectfully acknowledges Applicant's traversal of the Election of Species Requirement, however the Examiner does not find the Applicant's arguments persuasive. Components a), b) and c) of the instant invention comprise compounds with at least three variables, wherein each variable can comprise a multitude of chemical constituents. Hence, leading to a terrific number of possible chemical compounds, constituting a burdensome search. This election of species requirement is made final.

Applicant's elected species were searched. The search was not extended because prior art was found to render the species obvious.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-12 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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(i) Claim 10 is rejected for the use of improper Markush groups. See MPEP 2173.05(h) for examples of proper conventional or alternative Markush-type language (e.g., "...selected from the group consisting of. . .and . . ."). The Markush language of this claim is confusing. How does the 2<sup>nd</sup> part of (a5), the part following the gap, relate to the previous Markush language. How are (a1)-(a5) and (a6)-(a7) related?

(ii) The phrase "(keto groups)" in claim 10, (a7), is vague and indefinite, as it is not clear whether the information inside the parenthesis is intended to be claimed and it is further unclear how this phrase relates to the rest of the claim.

(iii) The phrase "glucose derivatives, which are characterized by the structural formula" in claim 10, b), is vague and indefinite. Since the glucose derivative is merely characterized by the formula, what other compounds are encompassed by this phrase?

(iv) The phrase "substituted aromatic alpha-hydroxyacids" in claim 11 (line 3) is vague and indefinite, as it is not clear what compounds or atoms are encompassed by the phrase "substituted" and furthermore unclear what compounds are encompassed by this phrase.

(v) Claim 12 is rejected for the use of improper Markush groups. See MPEP 2173.05(h) for examples of proper conventional or alternative Markush-type language (e.g., "...selected from the group consisting of. . .and . . ."). This claim is confusing. Why does the beginning half of the claim have the conjunction "and/or" between the groups and the last half of the claim have commas between the groups and the conjunction "and" prior to the last group?

(vi) A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

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Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 16 (lines 2-3) recites the broad recitation "0.1-25.0% by weight", and the claim also recites "preferably 0.5-15.0% by weight" which is the narrower statement of the range/limitation; claim 17 (lines 2-3) recites the broad recitation "0.1-25.0% by weight", and the claim also recites "preferably 0.5-15.05% by weight" which is the narrower statement of the range/limitation; claim 18 (lines 2-3) recites the broad recitation "20:1 to 1:20", and the claim also recites "preferably from 10:1 to 1:10, particularly preferably from 5:1 to 1:5, very particularly preferably from 2:1 to 1:2" which is the narrower statement of the range/limitation.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly

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owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10-12 and 14-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Bimczok et al. (5,961,999) or Muller et al. (6,248,338).

Bimczok et al. teach a method of skin care. Disclosed is a skin care preparation in the form of an emulsion comprising 3% polyglyceryl-3-methylglucose distearate and 0.5% citric acid. Lactic acid and citric acid are disclosed as interchangeable. See Col. 1, line 10-Col. 8, line 65.

Muller et al. teach compositions for the cleansing and caring for skin. Disclosed is an oil in water cream comprising 3% polyglyceryl-3 methylglucose distearate. It is disclosed that lactic acid can be added to the compositions of the invention to regulate pH. See Col. 5, line 10-Col. 26, line 40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the exemplified composition of Bimczok by substituting the citric acid in Example 1 for lactic acid and obtain a method of treating blemished skin or acne by applying a composition comprising polyglyceryl-3-methylglucose distearate and lactic acid because Bimczok teaches lactic acid as a preferred alpha hydroxy acid for use in his composition and further teaches citric acid and lactic acid as interchangeable alpha hydroxy acids.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the exemplified composition of Muller et al. by adding lactic acid and obtain a method of treating blemished skin or acne by applying a composition comprising polyglyceryl-3-methylglucose distearate and lactic acid because Muller teaches alpha hydroxy acids in his composition as pH regulators.

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The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

*Prior Art*

The prior art made of record and not specifically relied upon in any rejections cited above is either 1) considered cumulative to the prior art that was cited in a rejection or is 2) considered pertinent to the applicant's disclosure and shows the state of the art in its field but is not determined by the Examiner to read upon the invention currently being prosecuted in this application.

*Notes/Comments*

(i) The Examiner respectfully suggest in claim 1, part (c), that the phrase "if desired, furthermore" be replaced by the phrase "optionally"


(ii) The Examiner also respectfully suggests that Applicant use consistent Markush language throughout the claims.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

  
DAMERON L. JONES  
PRIMARY EXAMINER

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lqw

October 24, 2001